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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,018	02/05/2001	Roger N. Hastings	5236-000215	5479

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EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/18/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,018

Applicant(s)

HASTINGS ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant has cancelled claims 1-26 and added claims 27-42. In a telephone conversation with Applicant's attorney, Bryan Wheelock, on March, 8, 2004, applicant elects Species 13, Figures 14-16.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claim is unclear.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 27-33, 36-38, 40, and 42 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Ponzi in US Patent No. 5,964,757.

Regarding claim 27, Ponzi discloses a catheter (12) having a proximal and distal end and a lumen (18) therebetween; a support structure (19/36/14) in the lumen adjacent the distal end; one or more energy conduits (such as 40, 46, etc.) in the catheter, each having a distal end supported by the support structure (19/36); and one or more magnet members (such as 72 with 36 and 38) disposed in the distal end of the catheter, as recited throughout the specification with emphasis on column 9, and see in figures 2A-8.

Regarding claim 28, Ponzi discloses that as applied to claim 27, as well as, a support structure (19/36) that projects past the distal end of the catheter, as seen in figures 1-8.

Regarding claim 29, Ponzi discloses that as applied to claim 27, as well as, a support structure (19/36) that has one or more passages (such as 34, etc. tube 19 has three lumens) through which one or more energy conduits extend, as recited in columns 7-8 and seen in figures 1-8.

Regarding claim 30, Ponzi discloses that as applied to claim 29, as well as, at least one of the one or more passages that are defined around a central passage of the lumen, as seen in figures 1-8.

Regarding claim 31, Ponzi discloses that as applied to claim 30, as well as, a central passageway that is left open, as seen in the figures. The scope of "left open" has not been established. Thus, the lumen of Ponzi can be considered left open.

Regarding claim 32, Ponzi discloses that as applied to claim 27, as well as, on or more energy conduits (40) that are an electrode conductor, where the device further has an electrode (such as 36, 38) on the distal end of the electrode conductor, as recited in columns 7-8, with emphasis on column 7, lines 30-45 and seen in figures 1-8.

Regarding claim 33, Ponzi discloses that as applied to claim 27, as well as, one or more energy conduits (46) that is an optical fiber (46), as recited in column 8 and seen in figures 1-8.

Regarding claim 36, Ponzi discloses that as applied to claim 27, as well as, a support structure (19/14/36) that has one or more magnet members (such as 72, etc.), as recited in columns 9-10.

Regarding claim 37, Ponzi discloses that as applied to claim 27, as well as, a support structure (19/14/36) that is a sheath, as seen in figures 1-8.

Regarding claim 38, Ponzi discloses that as applied to claim 27, as well as, a support structure that has an ablation tool (46), as recited in column 8, lines 10-20.

Regarding claim 40, Ponzi discloses that as applied to claim 27, as well as, an ablation member (46) at the catheter distal end, as seen in figures 1-8.

Regarding claim 42, discloses that as applied to claim 27, as well as, a support structure that has a passage (78) for a guidewire, as recited in column 11, lines 65-67

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34, 35, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponzi in US Patent No. 5,964,757.

Regarding claim 34 and 35, Ponzi discloses that as applied to claim 27.

However, Ponzi does not explicitly recite an energy conduit distal end that is rotatable within the support structure and/or catheter. On the other hand, it would be obvious to one with ordinary skill in the art to modify the invention of Ponzi to include rotation for the purpose of increased flexibility to the system.

Regarding claim 39, Ponzi discloses that as applied to claim 27. However, Ponzi does not explicitly recite one or more magnet members that are positioned in the wall of the

catheter. On the other hand, the magnet members of Ponzi are positioned in the wall of the tip, which can be considered an equivalent.

Regarding claim 41, Ponzi discloses that as applied to claim 40. However, Ponzi does not recite one or more magnet members that are comprised by the ablation member. On the other hand, the scope of this claim is unclear. The electrode tip of Ponzi has the ablation laser.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 27-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-7, and 20 of copending Application No. 09/352,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely reworded representations of the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,428,551; US Patent No. 6,214,019; US Patent No. 5,941,869; US Patent No. 5,904,147; US Patent No. 5,865,738; US Patent No. 5,769,843; US Patent No. 5,592,939; and US Patent No. 5,358,509.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

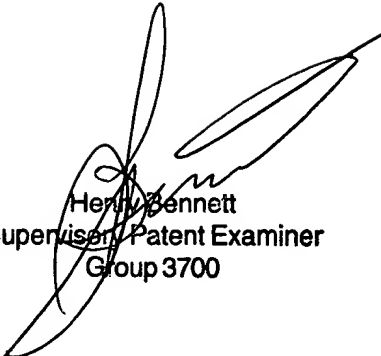
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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